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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/440,645	11/16/1999	AVERY FONG	5244-0109-2	3214
22850	7590	12/23/2010		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER CHANKONG, DOHM	
			ART UNIT 2452	PAPER NUMBER
			NOTIFICATION DATE 12/23/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

09/440,645

Applicant(s)

FONG ET AL.

Examiner

DOHM CHANKONG

Art Unit

2452

Period for Reply -- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5-10, 14-19, 23-28 and 32-36 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1, 5-10, 14-19, 23-28, and 32-36 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This non-final rejection is in response to Applicant's request for continued examination. Applicant amends claims 1, 10, 19, 28, and 32-36 and previously cancelled claims 2-4, 11-13, 20-22, and 29-31. Accordingly, Applicant presents claims 1, 5-10, 14-19, 23-28, and 32-36 for further examination.

I. CONTINUED EXAMINATION UNDER 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/10/2010 has been entered.

II. RESPONSE TO ARGUMENTS

Applicant's arguments with respect to claims 1, 5-10, 14-19, 23-28, and 32-36 have been considered but are moot in view of the new ground(s) of rejection.

III. DOUBLE PATENTING

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- A. Claims 1, 5-10, 14-19, 23-28, and 32-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6662225 [“225 patent”] in view of Miyachi, U.S. Patent No. 6108492.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because they only contain minor obvious differences as illustrated in the following table.

App. No. 09/440645	'225 Patent
<p>Claim 1. A system comprising: an image forming device having direct network access and including an operation panel, the operation panel comprising a plurality of buttons to be selected by a user;</p> <p>a monitoring unit configured to monitor data of selecting of the plurality of buttons of the operation panel by the user, including monitoring each of a sequence, timing, and frequency of selecting of the plurality of buttons, and to generate a log of the monitored data, the log of the monitored data being in a form of a map mapping each of key data in a key portion of the map to respective value data in a corresponding value data portion;</p> <p>a communicating unit configured to receive a command to send information based on the log of the monitored data, and to send the information of the monitored data through the direct network access, and</p> <p>wherein the monitoring unit and communicating unit are self-contained in the image forming device prior to any initial external communication connection by the communication unit, and the monitoring unit is configured to generate the log of the monitored data without any initial external communication connection by the communicating unit.</p>	<p>Claim 1. A system comprising: an interface of a target application, the interface comprising a plurality of operations to be selected by a user (Claim 3), wherein the target application is an image forming device and the interface is an operation panel of the image forming device</p> <p>a monitoring unit configured to monitor data of selecting of the plurality of operations of the interface by the user, and to generate a log of the monitored data, to package the log of the monitored data into either a first information object based on a first monitoring condition or a second information object based on a second monitoring condition using a packaging object derived from an abstract class; a setting unit configured to set either the first monitoring condition or the second monitoring condition;</p> <p>a communicating unit configured to receive one of the first and second information objects derived from the abstract class including the log of the monitored data, based on the set first or second monitoring condition, and to communicate the log of the monitored data by a unidirectional communication without requiring input from a device to which the log of the monitored data is communicated.</p>
<p>Claim 5. wherein the communicating unit sends the log of the monitored data when the user exits operating the image forming device.</p>	<p>Claim 5. wherein the communicating unit sends the log of the monitored data when the user exits the target application</p>
<p>Claim 6. a setting unit configured to set a number of sessions of the image forming device to be executed by the user prior to the</p>	<p>Claim 6. the setting unit is configured to set a number of sessions of the target application to be executed by the user prior to the</p>

communicating unit communicating the log of the monitored data.	communicating unit communicating the log of the monitored data
Claim 9. the communicating unit communicates the log of the monitored data by Internet mail.	Claim 8. the communicating unit communicates the log of the monitored data by Internet mail

The '225 patent discloses monitoring the selection of operations but does not specifically disclose monitoring selection of buttons. However, the claim language of the '225 patent discloses that the "operations" are from an operation panel of an image forming appliance. Similarly, the instant application discloses that the buttons are located on an operation panel.

Because an "operation panel" is well known in the art as having a plurality of buttons (because they are needed to control the image forming apparatus), it would be clear to one of ordinary skill in the art that the claimed operations in the '225 patent are synonymous with "buttons" in the instant application.

The '225 patent also does not expressly disclose the limitation of "wherein the monitoring unit and communicating unit are self-contained in the image forming device prior to any initial external communication connection by the communication unit, and the monitoring unit is configured to generate the log of the monitored data without any initial external communication connection by the communicating unit." Nor does the '225 patent disclose the limitations of claims 7 and 8. However, these features are obvious in view of Miyachi.

For example, Miyachi discloses the monitoring unit and communicating unit are self-contained in the image forming device prior to any initial external communication connection by the communication unit, and the monitoring unit is configured to generate the log of the monitored data without any initial external communication connection by the communicating unit (figure 2, item 110a and column 5, lines 57-65). Miyachi further discloses the key data and

the value data in the map both contain string data (columns 6-7, table 1) and the value data portion includes plural vectors in which each vector includes an array of strings (columns 6-7, table 1).

It would have been obvious to one of ordinary skill in the art to have reasonably inferred that the units disclosed in claim 1 of the '225 could be constructed into a single apparatus such as image forming device (disclosed in claim 3 of the '225 patent) based on what is taught in Miyachi. Moreover, it would have been obvious to have stored data in the fashion taught by Miyachi as storing data as string data and as a vector were well known in the art.

Similar arguments apply to claims 10, 14-19, 23-28, and 32-36 of the instant application.

B. Claims 1, 5-10, 14-19, 23-28, and 32-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 7131070 [“'070 patent”] in view of Miyachi, U.S. Patent No. 6108492.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they only contain minor obvious differences as illustrated in the following table.

App. No. 09/440645	'070 Patent
Claim 1. A system comprising: an image forming device having direct network access and including an operation panel, the operation panel comprising a plurality of buttons to be selected by a user; a monitoring unit configured to monitor data of selecting of the plurality of buttons of the operation panel by the user, including monitoring each of a sequence, timing, and frequency of selecting of the plurality of buttons, and to generate a log of the monitored	Claim 1. A system comprising: an interface of a target application, the interface comprising a plurality of operations to be selected by a user, wherein the target application is an image forming device and the interface is an operation panel of the image forming device; a monitoring unit configured to directly monitor user selections of the plurality of operations of the interface by the user automatically upon start-up of the target application without the user directly starting a monitoring program, and to generate a log of

<p>data, the log of the monitored data being in a form of a map mapping each of key data in a key portion of the map to respective value data in a corresponding value data portion;</p> <p>a communicating unit configured to receive a command to send information based on the log of the monitored data, and to send the information of the monitored data through the direct network access, and</p> <p>wherein the monitoring unit and communicating unit are self-contained in the image forming device prior to any initial external communication connection by the communication unit, and the monitoring unit is configured to generate the log of the monitored data without any initial external communication connection by the communicating unit.</p>	<p>the monitored data, the log indicating the selections of the plurality of operations by the user;</p> <p>a communicating device configured to communicate the log of the monitored data to a remote site, (claim 4), the communicating unit communicates the log of the monitored data by Internet mail (implies network access)</p> <p>(see limitation above: automatically upon start-up of the target application without the user directly starting a monitoring program)</p>
<p>Claim 5. wherein the communicating unit sends the log of the monitored data when the user exits operating the image forming device.</p>	<p>Claim 2. wherein the communicating unit sends the log of the monitored data when the user exits the target application</p>
<p>Claim 6. a setting unit configured to set a number of sessions of the image forming device to be executed by the user prior to the communicating unit communicating the log of the monitored data.</p>	<p>Claim 3. the setting unit is configured to set a number of sessions of the target application to be executed by the user prior to the communicating unit communicating the log of the monitored data</p>
<p>Claim 9. the communicating unit communicates the log of the monitored data by Internet mail.</p>	<p>Claim 4. the communicating unit communicates the log of the monitored data by Internet mail</p>

See rejection in sub-section A for why the differences between the claims of the instant application and the claims of the '070 patent are obvious in view of Miyachi.

- C. Claims 1, 5-10, 14-19, 23-28, and 32-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 7743133 [""133 patent""], in view of Miyachi.**

Claims 1-28 of the '133 patent are similar in subject matter and scope to claims 1-31 of the '225 patent and claims 1-16 of the '070 patent. Therefore, see rejection in sub-sections A and B for why the differences between the claims of the instant application the claims of the '133 patent are obvious in view of Miyachi.

- D. Claims 1, 5-10, 14-19, 23-28, and 32-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 7533344 [""344 patent""], in view of Miyachi.**

Claims 1-24 of the '344 patent are similar in subject matter and scope to claims 1-31 of the '225 patent and claims 1-16 of the '070 patent. Therefore, see rejection in sub-sections A and B for why the differences between the claims of the instant application the claims of the '344 patent are obvious in view of Miyachi.

IV. CONCLUSION

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday to Friday [10 am - 6 pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on (571)272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOHM CHANKONG/
Primary Examiner, Art Unit 2452